

REMARKS

This responds to the Office Action mailed on May 17, 2005, and the references cited therewith.

No claims are amended, claims 35 - 44 are withdrawn, and no claims are added; as a result, claims 25 - 34 are addressed below.

Double Patenting Rejection

Claims 25-34 were rejected under the judicially created doctrine of double patenting over claims 1-26 of U.S. Patent No. 5,889,941.

Claims 25-34 were rejected under the judicially created doctrine of double patenting over claims 1-13 of U.S. Patent No. 6,014,748.

Applicant will submit a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) to obviate these rejections after the claims are otherwise indicated as allowable.

§102 Rejection of the Claims

Claims 25-34 were rejected under 35 U.S.C. § 102(e) for anticipation by Provost (U.S. 6,335,799). Applicant does not admit that Provost is prior art, and reserves the right to swear behind it at a later date. Nevertheless, Applicant respectfully submits that the claims are distinguishable over Provost for the reasons argued below.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Independent claim 25 recites: “acquiring personalization equipment characteristics for particular personalization equipment. . .” and “translating the internal script into a data stream in accordance with the personalization equipment characteristics.” Applicant respectfully submits that neither b) acquiring personalization equipment characteristics, nor d) translating the internal script into a data stream to the particular personalization equipment is taught by Provost.

The Office Action relies on column 12, lines 20 – 26 and column 12, lines 38 – column 13 line 47 of Provost to supply the element “acquiring personalization equipment characteristics. . .” Provost states, at Column 12, lines 20-26, how “the printer 106 must be prepared 228 for

printing the card.” Provost describes, at column 12, lines 38 – column 13 line 47, a flow chart for the operations of “a card personalizer application program running on a personal computer 104 in conjunction with a host data processor 102.” However, Applicant submits that Provost does not shown particular types of personalization equipment and as a result does not teach “acquiring personalization equipment characteristics for particular personalization equipment.”

In addition, because Provost does not disclose acquiring personalization equipment characteristics, Applicant respectfully submits that there is also no teaching in Provost of “translating the internal script into a data stream in accordance with the personalization equipment characteristics” as recited in claim 25. In fact, the term “script” does not appear in Provost. Thus, Provost does not teach “the internal script” or its relation to the “personalization equipment characteristics.” Rather Column 12, line 54—Column 13, line 47, of Provost details only the steps involved during the printing of the information related to a client on the card.

Thus, Provost does not teach each element of claim 25 because Provost does not teach “acquiring personalization equipment characteristics for particular personalization equipment. .” and “translating the internal script into a data stream in accordance with the personalization equipment characteristics.”

Claims 26-34 depend, directly or indirectly, on claim 25 and are patentable over Provost for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 349-9592 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date Nov. 17, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17th day of November, 2005.

Amy Moriarty
Name

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